

REMARKS/ARGUMENTS

This application has been reviewed in light of the Office Action mailed on August 29, 2008. Claims 1-4 and 7-17 are pending in the application with claims 1 and 8 amended herein and being in independent form. Claim 7 has also been amended. Applicants respectfully submit that the present Amendment incorporates no new matter and is fully supported by the specification, and that the pending claims are allowable over the references of record. In view of the following remarks and arguments, Applicants respectfully request allowance of the above-identified application.

Claim Rejection – 35 U.S.C. §112

Claims 1 and 8 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants have amended claims 1 and 8 in a manner that is believed to overcome the rejection. Accordingly, withdrawal of the rejection is respectfully requested.

Claim Rejection – 35 U.S.C. §103

The Examiner has rejected claims 1-17 under 35 U.S.C. § 103 (a) as being unpatentable over commonly-owned U.S. Patent No. 5,573,534 to Stone ("Stone") in view of U.S. Patent No. 6,391,035 to Appleby et al. ("Appleby") and U.S. Patent No. 5,827,323 to Klieman et al. ("Klieman"). Applicants respectfully submit that when properly combined Stone, Appleby, or Klieman, do not render claims 1-4 and 7-17 unpatentable for at least the following reasons.

According to § 2143.03 of the MPEP, "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." It is

Applicants' position, that all the claim limitations of amended independent claims 1 and 8, of the above-referenced application, are not taught or suggested, either expressly or implicitly, by any of the above cited art of record either taken alone or in any conceivable working combination.

As conceded by the Examiner, Stone does not disclose, teach or even suggest a plurality of stops configured in manner as required by claims 1 and 8. The Examiner relies on Appleby for the teaching of a plurality of stops. Applicants respectfully submit that modifying the bipolar instrument disclosed in Stone with the plurality of stops disclosed in Appleby does not render amended claims 1 or 8 unpatentable.

As amended herein, claim 1 recites a laparoscopic bipolar electrosurgical instrument for sealing tissue, including, *inter alia*, a plurality of stops for maintaining a separation distance between opposable sealing surfaces wherein "...at least one of the stops being disposed on an opposable seal surface and at least one of the stops being located proximate the pivot, wherein the at least one stop disposed on the seal surface and the at least one stop disposed proximate the pivot provide different separation distances between the opposable seal surfaces."

Likewise, claim 8 recites a laparoscopic bipolar electrosurgical instrument for sealing tissue, including, *inter alia*, a plurality of stops discretely disposed on at least one of the jaw members for maintaining a separation distance between the opposable sealing surfaces wherein "...at least one of the stops being located distally relative to the pivot and configured to provide a first separation distance, and at least one of the stops being located proximate the pivot and configured to provide a second separation distance."

Support for each of the above amendments can at least be found in the last paragraph on page 14 and the first paragraph on page 15, and in FIGS. 2 and 3 of Applicants' present disclosure.

As noted in Applicants' disclosure, a "stop 90 maintains a minimum separation distance in the range of about 0.03 millimeters to about 0.16 millimeters between the seal surfaces 39 and 40. See lines 26-30 on page 14. According to an embodiment of Applicants' disclosure, "instrument 10 includes a second or alternative stop 95 which is designed to maintain a minimum separation of at least about 0.03 millimeters between the seal surfaces 39 and 40." (See, e.g., lines 1-5 on page 15.) Conceivably, each of the stop members 90 and 95 may be configured to provide a different separation distance between the seal surfaces 39 and 40. This configuration may enhance the sealing effect along longer jaws, i.e., provide a more consistent thickness along the length of the tissue seal from the proximal end of the jaws to the distal end.

Nowhere does Appleby teach or suggest a laparoscopic bipolar electrosurgical instrument for sealing tissue, including, *inter alia*, a plurality of stops configured in a manner as required by claims 1 and 8 of Applicants' present disclosure. As noted in Applicants' previous response Appleby relates to a "forceps-type ligating or hemostatic clip removal instrument 10 configured for removing polymeric ligating or hemostatic clips 12 from a latched condition." See col. 3, lines 28-32 of the Appleby disclosure. As noted by the Examiner, Appleby teaches "a stop 84 or 86, disposed on or disposed adjacent to at least one of the sealing surfaces of two jaw members 80 and 82, the stop being located distally relative to the pivot 54 about which each of the jaw members is movable." See col. 4, lines 44-46 and FIG. 2 (reproduced below). According to Appleby, "[t]he outer ends of jaws 80 and 82 are provided with terminal clip engaging surfaces 90 and 92 adjacent the stop surfaces 84 and 86..." As noted in Appleby, having the jaws 80 and 82 configured in such a manner is critical to the success of removing the clip (see col. 5, lines 33-35).

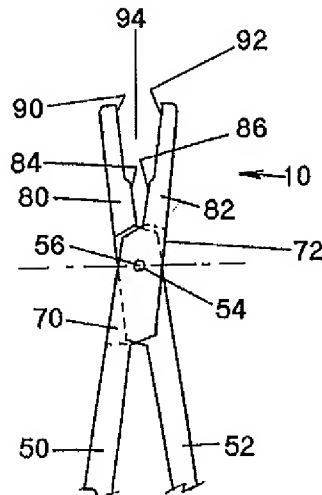


FIG. 2

Nowhere in the Appleby reference is it disclosed that the stop surfaces **84** and **86** may be located at any place on the forceps other than as indicated above. It is Applicants' position that having the stops disposed at discrete locations on the jaw members distally and proximate the pivot and configured to provide different separation distances, as recited in claims 1 and 8, is patentably distinguishable from having the stops disposed distally and at equal distances from the pivot, as taught by Appleby. That is, the relative distance between the jaw members may be more accurately controlled along the length of the jaw members (which is essential for effective vessel sealing) with jaw members configured in a manner as required by claims 1 and 8.

Thus, Appleby does not teach or suggest a laparoscopic bipolar electrocautery instrument for sealing tissue, including, *inter alia*, a plurality of stops for maintaining a separation distance between opposable sealing surfaces wherein "...at least one of the stops being disposed on an opposable seal surface and at least one of the stops being located proximate the pivot, wherein the at least one stop disposed on the opposable seal surface and the at least one stop disposed proximate the pivot provide different separation distances between the opposable seal surfaces," as required in claim 1, or a laparoscopic bipolar electrocautery

instrument for sealing tissue, including, *inter alia*, a plurality of stops discretely disposed on at least one of the jaw members for maintaining a separation distance between the opposable sealing surfaces wherein "...at least one of the stops being located distally relative to the pivot and configured to provide a first separation distance, and at least one of the stops being located proximate the pivot and configured to provide a second separation distance," as required in claim 8.

Accordingly, in view of the foregoing amendments to claims 1 and 8 and in view of the foregoing remarks/arguments, Applicants respectfully submit that the rejection of claims 1 and 8, as being obvious under 35 U.S.C. §103(a) over Stone in view of Appleby has been overcome and should be withdrawn.

Since claims 2-4, 7 and 9-17 depend, directly or indirectly, from claims 1 and 8, respectively, and contain all of the features of claims 1 and 8, Applicants respectfully submit that claims 2-4, 7 and 9-17 are also patentable over Stone in view of Appleby.

The Examiner relies on Klieman for teaching a means for maintaining a closure force between opposable sealing surfaces **40** and **44**. Klieman shows a locking mechanism that allows the end effector pieces **40** and **44** to be "clamped" on tissue or closed during a surgical procedure and kept locked in that closed position. See col. 10, lines 13-15. Applicants respectfully submit that Klieman does not cure the deficiencies of Stone with respect to claims 1 and 8 in that Klieman fails to disclose, teach or even suggest, a plurality of stops configured in a manner as required in claims 1 and 8. Accordingly, Applicants submit that claims 1 and 8 and any claims depending either directly or indirect therefrom, namely, claims 2-7 and 9-17 are allowable under 35 U.S.C. 103 (a) over Stone in view of Appleby and in further view of Klieman.

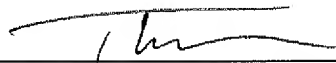
CONCLUSION

In view of the foregoing amendments and/or remarks, it is respectfully submitted that all claims presently pending in the application, namely, claims 1-4 and 7-17, are believed to be in condition for allowance.

If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call the Applicants' undersigned attorney at the Examiner's convenience.

Please charge any deficiency as well as any other fee(s) that may become due under 37 C.F.R. § 1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s), to Deposit Account No. 21-0550.

Respectfully submitted,



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